

REMARKS

Applicant has carefully reviewed the Final Office Action of July 13, 2004, and offers the following remarks in response thereto. Applicant amends claim 11 to correct a typographical error. Applicant further amends claims 13, 15, and 16 into independent form. These claims were objected to as being allowable, but for their dependency on a rejected base claim. The amendment places the claims in a condition for allowance. Applicant encloses a credit card payment form to cover the fees for the extra independent claims.

Applicant also adds new claims 52-56 which further define traffic information. The enclosed credit card payment form also includes the fees for these new claims.

Claims 12-17, 26, 30, 31, 37, 39-41, 44, and 50 are amended to correct typographical errors and make the antecedent basis consistent throughout the claim set. No new matter is added.

Applicant now turns to the Response to Arguments section of the Office Action.

Initially, Applicant traverses the Patent Office's assertion on page 2 of the Office Action that Applicant is referring to a different Application relating to a different Examiner. Applicant has reviewed Applicant's representative's phone bill and notes that it shows calls to 703-305-4072 on April 13, 2004 at 3:39PM and April 19, 2004 at 4:18PM. Applicant's representative left messages in both instances, and neither phone call was returned.

With respect to Applicant's argument in the last two paragraphs of page 12 of the Response of May 4, 2004, Applicant is unclear as to which argument the Patent Office is responding. The Patent Office states "the Examiner maintains that the claim limitations need not be rejected in the order claimed." Applicant did not make this argument. In the second to last paragraph, Applicant argued that for an anticipation rejection, the elements of the reference must be arranged as claimed, along with a citation to MPEP § 2131. Applicant supplements this position with a citation to *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1349 (Fed. Cir. 1998) (stating "a finding of anticipation requires that the publication describe all of the elements of the claims, arranged as in the patented device."). If the Patent Office "maintains that the claim limitations need not be" present in the reference in the order claimed, then the Patent Office is invited to identify on what authority the Patent Office relies for this position, because the clear precedent from the Federal Circuit is that the elements of the reference must be arranged as claimed.

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If the Patent Office is addressing the final paragraph on page 12 of the Response of May 4, 2004, then Applicant responds as follows. In the final paragraph, Applicant pointed out that 37 C.F.R. § 1.104(c)(2) requires that the Patent Office explain with particularity how a reference is being applied to the claims. Applicant herein expands this argument. 37 C.F.R. § 1.104(c)(2) states "When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified." Applicant has presented fifty-one claims. The reference used to reject these claims is voluminous. 37 C.F.R. § 1.104(c)(2) requires more than a single paragraph of explanation.

Claims 1-12 and 17-51 were rejected under 35 U.S.C. § 102(b) as being anticipated by Moroto et al. (hereinafter "Moroto"). Applicant respectfully traverses. For the Patent Office to establish anticipation, the Patent Office must show where each and every element of the claim is shown in the reference. Furthermore, the elements of the reference must be arranged as claimed. MPEP § 2131. The two requirements articulated by MPEP § 2131 are strict requirements, and any lack of identity between the reference and the claimed invention is sufficient to defeat an allegation of anticipation.

Applicant argued in the previous response that Moroto does not show "traffic information" as that term is used by someone of ordinary skill in the art. The Patent Office responds by indicating that the traffic information is taught at Moroto, column 30, lines 47-60 and an indication that Figures 1, 3, and 5-7 also are relevant. Moroto, column 30, lines 47-60 states in full:

According to the foregoing embodiment of the navigation system for displaying a more detailed map as a set point is approached, the map data is classified in the layer structure so that roads of different ranks are automatically emphasized according to the distances from the starting point, the destination and the inputted transit points. As a result, even in case a plurality of points are set, a detailed map can be displayed when close to each of the set points whereas a coarse map can be displayed when between the individual points, depending upon the distances. Thus, there can be attained an advantage that the driver can easily acquire the necessary detailed map information to change the route from the present position in the map display when the traffic is cut off or in a snarl.

Applicant respectfully traverses the assertion that it is clear that traffic information is taught. As explained in the previous response, in the context of the current application, traffic information

relates to volume of traffic and the presence or absence of an accident. This is the meaning that someone of ordinary skill in the art would give the term "traffic information." This meaning is confirmed as the broad reasonable interpretation by reference to two online dictionaries. Specifically, www.dictionary.com defines traffic *inter alia* as "the passage of people or vehicles along routes of transportation." Likewise, Merriam Webster's online dictionary (www.m-w.com) defines traffic *inter alia* as "4. a : the movement (as of vehicles or pedestrians) through an area or along a route b : the vehicles, pedestrians, ships, or planes moving along a route." (Attached as Exhibits A and B, respectively). The cited passage does not teach traffic information as that term is understood by someone of ordinary skill in the art. That is, the cited passage talks about maps and routes, but does not provide any information about the movement or passage of vehicles or pedestrians along a route. In fact, the absence of such information is highlighted by the last sentence of the cited passage which indicates that if the user is caught in traffic, the user may use Moroto's invention to select an alternate route. Selecting an alternate route is not providing traffic information as recited in the claim. Since the reference does not teach or suggest the recited traffic information, and all the independent claims recite traffic information, the claims are not anticipated. Since the claims are not anticipated, the rejection is improper, and the claims are allowable.

The other citations provided by the Examiner likewise do not teach "traffic information" as that term is understood. Figure 1 of Moroto does not have any element that is readily identifiable as traffic information. Figure 1 shows a route setting 32 and a point recognition 31, but these are not, under any reasonable interpretation, traffic information. Figure 3 of Moroto has route information, but this pertains to the size of the roads, and not traffic information on the route. Figures 5-7 of Moroto illustrate exemplary screens showing the route, but there is no traffic information displayed about the route. That is, there is no teaching or suggestion that any traffic volume, accident presence, or accident absence is shared with the user. To this extent, the reference's cited Figures do not teach or suggest the claim element.

Applicant asked, in the previous response, for a more detailed explanation of how the reference shows all the claim elements. The Patent Office has not provided such an explanation. If the Patent Office provides the missing explanation, Applicant requests that the Patent Office withdraw the finality of the current Office Action so that Applicant can respond to this new explanation. In preparation for an appeal, Applicant further expands on the ways that the

dependent claims are not anticipated, and how the Patent Office has not explained how the claims are anticipated by Moroto.

Claim 2 recites "wherein at least one travel time is associated with the learned route . . . and . . . determining if a current time corresponds to the at least one travel time associated with the learned route." The Patent Office never addresses this claim element or identifies where this element is taught in the reference. If the Patent Office disagrees, the Patent Office is invited to identify with particularity where this element is taught in Moroto. In the event that this element is identified, Applicant requests that the finality be withdrawn so that Applicant is afforded an opportunity to respond to the new explanation. The Patent Office does indicate that traffic information is provided over a period of time, but the claim does not recite the provision of traffic information over time, so the Patent Office has not shown how the claim is anticipated. Since the Patent Office has not proven anticipation, the claim is allowable.

Claim 3 recites "predicting one of the at least one destinations as a most likely destination based on the current time and the at least one travel time associated with the learned route" The Patent Office never addresses this claim element or identifies where this element is taught in the reference. If the Patent Office disagrees, the Patent Office is invited to identify with particularity where this element is taught in Moroto. In the event that this element is identified, Applicant requests that the finality be withdrawn so that Applicant is afforded an opportunity to respond to the new explanation. The Patent Office does indicate that traffic information is provided over a period of time, but the claim does not recite the provision of traffic information over time, so the Patent Office has not shown how the claim is anticipated. Since the Patent Office has not proven anticipation, the claim is allowable. Claims 21 and 33 are similar and are not anticipated at least for the same reasons.

Claim 4 recites "comparing the location of the mobile terminal with location information associated with the learned route to determine if travel on the learned route is likely." The Patent Office never addresses this claim element. While the Patent Office opines that "position detecting section 1020" is relevant, there is no teaching or suggestion in the text that shows that the data from the GPS receiver is ever compared to the learned route, nor is there a determination if travel on the learned route is likely as recited in the claim. If the Patent Office disagrees, the Patent Office is invited to identify with particularity where this element is taught in Moroto. In the event that this element is identified, Applicant requests that the finality be withdrawn so that

Applicant is afforded an opportunity to respond to the new explanation. Since the Patent Office has not proven anticipation, the claim is allowable. Claim 34 is similar and is not anticipated at least for the same reasons.

Claim 5 recites "the direction of travel bears on the traffic information delivered to the user of the mobile terminal." While there is a direction sensor in Moroto, there is no indication that the information provided to the user is delivered based on the direction of travel. If the Patent Office disagrees, the Patent Office is invited to identify with particularity where this element is taught in Moroto. In the event that this element is identified, Applicant requests that the finality be withdrawn so that Applicant is afforded an opportunity to respond to the new explanation. Since the Patent Office has not proven anticipation, the claim is allowable.

Claim 6 recites "determining if a current time corresponds to the at least one travel time associated with the learned route" The Patent Office never addresses this claim element. If the Patent Office disagrees, the Patent Office is invited to identify with particularity where this element is taught in Moroto. In the event that this element is identified, Applicant requests that the finality be withdrawn so that Applicant is afforded an opportunity to respond to the new explanation. The Patent Office does indicate that traffic information is provided over a period of time, but the claim does not recite the provision of traffic information over time, so the Patent Office has not shown how the claim is anticipated. Since the Patent Office has not proven anticipation, the claim is allowable.

Claim 7 recites "predicting a most likely destination as one of the at least one destinations associated with the learned route based on determining a direction of travel along the learned route" The Patent Office never addresses this claim element. If the Patent Office disagrees, the Patent Office is invited to identify with particularity where this element is taught in Moroto. In the event that this element is identified, Applicant requests that the finality be withdrawn so that Applicant is afforded an opportunity to respond to the new explanation. Since the Patent Office has not proven anticipation, the claim is allowable.

Claim 9 recites "recording locations of the mobile terminal traveling along a traveled route; and processing the locations to define the learned route." The Patent Office never addresses these claim elements. The routes of Moroto are not learned by recording locations, and thus, recorded locations are not processed to define the learned route. If the Patent Office disagrees, the Patent Office is invited to identify with particularity where this element is taught in

Moroto. In the event that this element is identified, Applicant requests that the finality be withdrawn so that Applicant is afforded an opportunity to respond to the new explanation. Since the Patent Office has not proven anticipation, the claim is allowable. Claim 42 recites a similar element and is allowable at least for the same reasons.

Claim 10 recites "recording locations in response to the first user command" The Patent Office never addresses this element. While the Patent Office does opine that there are first and second commands in Figure 1, these commands do not record locations as recited in the claim. If the Patent Office disagrees, the Patent Office is invited to identify with particularity where this element is taught in Moroto. In the event that this element is identified, Applicant requests that the finality be withdrawn so that Applicant is afforded an opportunity to respond to the new explanation. Since the Patent Office has not proven anticipation, the claim is allowable.

Claim 11 recites "correlating the locations with roadway information to identify at least one road segment associated with the locations" The Patent Office does not address this claim element. While Moroto discloses using road segments to plan routes, the road segments are not identified based on recorded locations as recited in the claim. If the Patent Office disagrees, the Patent Office is invited to identify with particularity where this element is taught in Moroto. In the event that this element is identified, Applicant requests that the finality be withdrawn so that Applicant is afforded an opportunity to respond to the new explanation. Since the Patent Office has not proven anticipation, the claim is allowable. Claim 44 recites a similar element and is allowable at least for the same reasons.

Claim 12 recites "periodically recording data including at least a location of the mobile terminal over a period of time" As explained above, Moroto does not record data including the location of the mobile terminal. While the position of the mobile terminal is sensed, there is no indication that the data is recorded. If the Patent Office disagrees, the Patent Office is invited to identify with particularity where this element is taught in Moroto. In the event that this element is identified, Applicant requests that the finality be withdrawn so that Applicant is afforded an opportunity to respond to the new explanation. Since the Patent Office has not proven anticipation, the claim is allowable.

Claim 17, as amended, recites processing the traffic information to determine if an undesirable condition is indicated. The traffic snarl of Moroto is not within the traffic information, but rather is a condition observed by the vehicle operator. To this extent, the

portions of the reference highlighted by the Patent Office do not show a claim element. If the Patent Office disagrees, the Patent Office is invited to identify with particularity where this element is taught in Moroto. In the event that this element is identified, Applicant requests that the finality be withdrawn so that Applicant is afforded an opportunity to respond to the new explanation. Since the Patent Office has not proven anticipation, the claim is allowable. Claim 30 recites a similar element and is likewise allowable.

Claim 18 recites delivering traffic information pertaining to an alternate route if the undesirable condition is indicated. While Moroto contemplates the user requesting alternate route information if the user is caught in a traffic snarl, the Moroto system does not deliver traffic information about the alternate route. Moroto merely provides the street names and directions about the alternate route - not traffic information. If the Patent Office disagrees, the Patent Office is invited to identify with particularity where this element is taught in Moroto. In the event that this element is identified, Applicant requests that the finality be withdrawn so that Applicant is afforded an opportunity to respond to the new explanation. Since the Patent Office has not proven anticipation, the claim is allowable. Claim 30 recites a similar element and is likewise independently allowable for this reason as well. Claim 35 likewise recites a similar element and is allowable at least for the same reasons.

Claim 23 recites determining if travel on a learned route is likely based on comparing a current time and current location of the mobile terminal to learned route information. The Patent Office never addresses this claim element or identifies where this element is taught in the reference. If the Patent Office disagrees, the Patent Office is invited to identify with particularity where this element is taught in Moroto. The Patent Office does indicate that traffic information is provided over time, but the claim does not recite the provision of traffic information over time, so the Patent Office has not shown how the claim is anticipated. In the event that this element is identified, Applicant requests that the finality be withdrawn so that Applicant is afforded an opportunity to respond to the new explanation. Since the Patent Office has not proven anticipation, the claim is allowable.

Claim 36 recites prompting the user to input customizable settings used to define at least one undesirable condition. The Patent Office never addresses this claim element. If the Patent Office disagrees, the Patent Office is invited to identify with particularity where this element is taught in Moroto. In the event that this element is identified, Applicant requests that the finality

be withdrawn so that Applicant is afforded an opportunity to respond to the new explanation. Since the Patent Office has not proven anticipation, the claim is allowable.

Claim 38 recites instructing the cellular phone to record time information periodically and to process the data to identify at least one travel time for each of the at least one learned routes. The Patent Office never addresses these claim elements. While the Patent Office does indicate that Moroto teaches delivery of information over time, the claim does not recite such. If the Patent Office disagrees about the content of the claim and/or the contents of the reference, the Patent Office is invited to identify with particularity where this element is taught in Moroto. In the event that this element is identified, Applicant requests that the finality be withdrawn so that Applicant is afforded an opportunity to respond to the new explanation. Since the Patent Office has not proven anticipation, the claim is allowable.

Applicant requests reconsideration of the rejection in light of the amendments and remarks presented herein. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

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